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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09-761,988 | 01-16-2001 | Kunio Arimoto | OPS Case 519 | 5747 |

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EXAMINER

UMEZ ERONINI, LYNETTE T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1765 | 5 |

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-------------------------|-----------------|---------------|
| | Application No. | Applicant(s) |
| | 09/761,988 | ARIMOTO ET AL |
| Examiner | Art Unit | |
| Lynette T. Umez-Eronini | 1765 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
 - 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 7 and 8 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a composition, classified in class 524, subclass 1⁺.
 - II. Claim 7, drawn to method of coating, classified in class 428, subclass 1⁺.
 - iii. Claim 8, drawn to method of removing a composition from a substrate, classified in class 134, subclass 1+.
2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, such as one that does not require coating a window of a vehicle or building.
3. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the method of coating a composition on a glass substrate in invention II is not required in removing the composition from the glass substrate.
4. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as one that does not require removing the composition by using an alkaline detergent.

5. During a telephone conversation with Terryence L. Chapman on September 13, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7 and 8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines, 10-13, "wherein said reaction product is one obtained by reaction between the epoxy group-containing alkoysilane (a-1) and the amino group-containing alkoxysilane (a-2) having active hydrogen therein at a ratio by weight of 6:4 to 9:1" is indefinite because it is unclear whether the ratio refers to the active hydrogens in the amino group-containing alkoysilane (a-2) or the active hydrogens in the reaction product that is obtained by the reaction between (a-1) and (a-2). For examining, the weight ratio of compounds, (a-1) and (a-2) would be searched.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nambu et al. (US 5,063,114).

Nambu teaches a topcoat clear coating (same as a colored, transparent film-forming composition) that comprises silane compounds, condensation products thereof, reaction products thereof or a mixture thereof of. Examples of the above silane compounds include γ -glycidoxypyropyltrimethoxysilane (same as (a-1)) and N-(β -aminoethyl)- γ -aminopropylmethyldimethyl (same as (a-2)), (column 2, lines 16-17 and column 11, lines 15-21, 25-26, and 39), which reads on,

(a) a reaction product of an epoxy group-containing alkoysilane (a-1) and an amino group-containing alkoxysilane (a-2) having active hydrogen therein;

a condensation catalyst such as sulfuric acid (column 11, lines 48-49), which the same as,

(b) an acid catalyst;

UV absorber in an amount of 0.1 to 10 parts, per 100 parts of the solid components of the topcoat clear coating (column 12 lines 43-46) and that includes benzophenone and triazole (column 12, lines 2-27), which is the same as

(c) an alkali-soluble UV absorber;

a solvent for the topcoat includes n-amyl and octyl alcohol (column 8, line 53 – column 9, line 6) that has boiling points respectively of 137°C and 194-195°C (see Hawley's Condensed Chemical Dictionary), which reads on,

(d) at least one solvent selected from organic solvents having a boiling point of 100 to 250°C; and

(e) a dye and /or a pigment (column 12, lines 64-65 and column 13, lines 24).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nambu as applied to claim 1 above, and further in view of Ramesh (US 5,925,285).

Nambu differs in failing to specify the weight ratio of the epoxy group-containing alkoysilane (a-1) to the amino group-containing alkoysilane (a-2) as 6.4 to 9.

Ramesh teaches the weight amounts of crosslinker component and polyfunctional epoxy compound will be dependent upon factors including, for example, the particular materials chosen, the presence of other reactive species as well as the desired end use. Based upon these variables and others, those of ordinary skill in the art should be able to adjust the composition of the coatings (including the relative amounts of the components) to achieve the desired effect (column 8, lines 25-33).

It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to modify the reactants of Nambu's coating composition by varying the weight ratio of the components of a coating composition as taught by Ramesh for the purpose of achieving a desired effect.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hawley's Condensed Chemical Dictionary is relied upon to teach the boiling points of organic solvents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynette T. Umez-Eronini whose telephone number is 703-306-9074. The examiner is normally unavailable reached on the First Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech can be reached on 703-308-3836. The fax phone numbers for the organization where this application or proceeding is assigned are 703-972-9310 for regular communications and 703-972-9311 for After Final communications.

Itue
September 19, 2002

Ben Utech
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